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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,018	06/24/2003	Joel K. Zupancic	1199 P 186	2586

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Roger H. Stein, Esq.  
Wallenstein & Wagner, Ltd.  
53rd Floor  
311 South Wacker Drive  
Chicago, IL 60606-6630

EXAMINER
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GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/603,018

**Applicant(s)**

ZUPANCIC ET AL.

**Examiner**

Stephen Gravini

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 21-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 21-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-22 and 24-25 are rejected under 35 U.S.C. 101 because those claims are considered to contain non-functional descriptive material which is not patentable under current Office practice.

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).) Purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture.

Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter.

In this application, the claimed recitations including receiving, initiating, incrementing, determining, generating, repeating continuously, and re-initiating are reasonably and broadly construed in light of the specification to be descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed and does not constitute a statutory process, machine, manufacture or composition of matter. The independently claimed counter is broadly and reasonably construed from applicants' specification paragraph [0029] to be merely a computing process performed such that it does not constitute a statutory process, machine, manufacture or composition of matter because it can be interpreted to be a value as claimed such that the claimed invention is merely a mathematical algorithm which may be performed without pre-empting other uses of a mathematical principle.

Because the claimed invention is considered to recite non-functional descriptive material, it is rejected as containing non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a device operable connected to a programmable logic controller, does not reasonably provide enablement for a method for controlling a device. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to enable a method for controlling a

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device without pre-empting other uses of a mathematical principle such that the invention is commensurate in scope with these claims. Since the invention contains non-statutory subject matter, as rejected above, it is also considered non-enabling to those skilled in the art.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Those claims contain recitations of receiving, initiating, incrementing, determining, generating, repeating continuously, and re-initiating which are considered failure to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Those recitations involve a method for controlling a device without pre-empting other uses of a mathematical principle such that the invention could be infringed by others using the same claimed mathematical principle. Furthermore, claim 24 contains the recitation "the device" which is considered indefinite since no earlier devices are claimed in its line of dependency.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 21-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Deschaaf et al. (US 4,385,452).

Claims 28-35 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kuroda et al. (US 5,852,881).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deschaaf in view of Dulay et al. (US 5,117,562). Deschaaf is considered to disclose the claimed invention, as rejected above, except for the claimed at least one of a plurality of lamps. Dulay, another method for controlling a device, is considered to disclose at least one of a plurality of lamps at column 8 lines 4-66. It would have been obvious to one skilled in the art to combine the teachings of Deschaaf with at least one of a plurality of

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lamps, considered disclosed by Dulay for the purpose of increasing the safety of an operator and conserving the bulb life of lamps by inadvertently starting.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda in view of Dulay. Kuroda is considered to disclose the claimed invention, as rejected above, except for the claimed at least one of a plurality of lamps. Dulay, another system for controlling a device, is considered to disclose at least one of a plurality of lamps at column 8 lines 4-66. It would have been obvious to one skilled in the art to combine the teachings of Kuroda with at least one of a plurality of lamps, considered disclosed by Dulay for the purpose of increasing the safety of an operator and conserving the bulb life of lamps by inadvertently starting.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lueckenbach (US 6,751,888) in view of Dulay. Lueckenbach is considered to disclose the claimed invention comprising:

a power intensity selector **102** for selecting a power intensity value;

a time cycle selector **70** for selecting a duration value wherein the disclosed selector knob is considered to expressly disclose the claimed time cycle selector at column 3 line 40 because both allow time cycle selection;

a temperature selector **102** for selecting a temperature value wherein the disclose controller is considered to inherently anticipate the claimed temperature selector since that device controls heating elements at column 3 line 60 such that heating element control directly correlates to temperature selection;

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a base resolution selector **124** for selecting a base resolution wherein the disclosed thermostat is considered to inherently disclose the claimed base resolution selector because both provide a base resolution for a particular desired value;

a selector **104** for selecting the power intensity output signal; and

an application module **100** configured to initiate a counter;

increment the counter by the power intensity value as disclosed in column 4 line 57 through column 5 line 20;

determine whether the counter is greater than the base resolution as disclosed in column 6 lines 10-27;

upon a determination that the counter is greater than the base resolution, generate a power intensity output signal and decrementing the counter by the base resolution as disclosed in column 6 lines 10-55;

otherwise, increment the counter by the power intensity value as disclosed in column 7 lines 1-27;

sense the temperature of an element of the system as disclosed in column 4 lines 7-20;

determine whether the temperature of the element of the system has exceeded the temperature value as disclosed in column 5 lines 21-39;

upon a determination that the temperature of the element of the system has exceeded the temperature value, generate a system shutdown signal as disclosed in column 6 line 47 through column 7 line 7; and



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upon a determination that the counter has exceeded the duration value, generate a system shutdown signal as disclosed in column 6 line 4 through column 7 line 43.

Lueckenbach is considered to disclose the claimed invention except for the claimed at least one of a plurality of lamps. Dulay, another method and/or system for controlling a device, is considered to disclose at least one of a plurality of lamps at column 8 lines 4-66. It would have been obvious to one skilled in the art to combine the teachings of Lueckenbach with at least one of a plurality of lamps, considered disclosed by Dulay for the purpose of increasing the safety of an operator and conserving the bulb life of lamps by inadvertently starting.

### ***Response to Arguments***

Applicant's arguments with respect to claims 21-37 have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gravini whose telephone number is 571 272 4875. The examiner can normally be reached on normal weekday business hours (east coast time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571 272 4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMG  
March 8, 2006

*Stephen Garm*